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EXAMINING GROUP 1712

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

CARNAHAN et al.

Group Art Unit: 2856

Application No.: 09/665,767

Examiner: Michael Cygan

Filed: September 20, 2000

For: METHOD AND APPARATUS FOR RAPID DETERMINATION OF POLYMER
MOLECULAR WEIGHTREQUEST FOR RECONSIDERATION

Assistant Commissioner for Patents

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Washington, D. C. 20231

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Sir:

Claims 1 to 37 are pending. The March 12 Final Rejection rejects claims 1 to 37.

Reconsideration and allowance are requested for the following reasons:

Claims 1 to 3, 9 to 29, 31 to 33, 36 and 37 were rejected under 35 U.S.C. §103(a) over Miroslav and Nielsen et al. and claims 4 to 8, 30, 34 and 35 were rejected under 35 U.S.C. §103(a) over Miroslav, Nielsen et al. and Fyvie et al. The Miroslav and Nielsen et al. references are overcome by Applicants' February 8 2002 Declaration under 37 C.F.R. §1.131. The Declaration establishes the date of the claimed invention prior to the April 2, 1999 Nielsen et al. U.S. filing date and prior to the October 1, 1999 Miroslav U.S. filing. The rejections of claims 1 to 3, 9 to 29, 31 to 33, 36 and 37 under 35 U.S.C. §103(a) over Miroslav and Nielsen et al. and claims 4 to 8, 30, 34 and 35 under 35 U.S.C. §103(a) over Miroslav, Nielsen et al. and Fyvie et al. must be withdrawn. See 37 C.F.R. §1.131.

The Final Rejection argues that "[w]hile the declaration under CFR 131 states that the invention was invented 'prior to April 2, 1999', the effective 102(e) date of the references is

the date of the filing of the provisional application, April 3, 1998," citing MPEP 901.04. This argument is incorrect for at least two reasons.

First, the PTO has not established that Nielsen is entitled to the provisional priority date for the subject matter that the PTO relies upon to reject the present application.

The Final Rejection states that Nielsen et al. allegedly discloses (1) "total analysis time," (2) "not more than 1 second per sample," (3) "multiple angles... for light scattering measurements," (4) "sequential analysis using detectors" and (5) "online techniques." Applicants' Declaration shows invention prior to as much of (1) through (5) shown in the Nielsen et al. patent. The Declaration establishes a prior "completion of the invention commensurate with the extent the invention is shown in the reference...." See *In re Wakefield and Foster*, 164 USPQ 636, 639 (CCPA 1970).

The Applicants are "entitled to a patent unless" "the invention was described in... a patent granted on an application... before the invention by the applicant(s)." See 35 U.S.C. §102 (e). The MPEP 901.04 states that "[t]he 35 U.S.C. 102(e) date for a nonprovisional application claiming the benefit of a prior provisional application (35 U.S.C. 111(b)) is the filing date of the provisional application." However, the PTO has failed to establish that Nielsen et al. "claim the benefit of" of the (1) through (5) disclosure that the PTO relies upon to reject the claims. "Unless" the PTO establishes that (1) through (5) are disclosed in the April 3, 1998 provisional application, the Applicants are entitled to a patent.

Second, the Miroslav reference is overcome by the Declaration.

MPEP 2136.03 includes the heading "PARENT'S FILING DATE WHEN THE REFERENCE IS A CONTINUATION-IN-PART OF THE PARENT" and states:

In order to carry back the 35 U.S.C. 102(e) critical date of the U.S. patent reference to the filing date of a parent application, the parent application must... support the invention claimed as required by 35 U.S.C. 112, first paragraph.

The Final Rejection contends that Miroslav discloses (6) "the claimed invention, an analysis system and method for polymer weight determination," (7) injecting a known amount of sample into an analysis system (8) containing a GPC column, (9) a concentration detector and (10) a molar mass detector (such as a differential refractive index detector and (11) a light scattering detector, (12) wherein a high molecular weight fraction is separated with minimal dispersion and (13) is analyzed. Miroslav is a Continuation In Part (CIP) of Nielsen et al. Nielsen et al. (the parent application) does not support (7) through (13).^{*} Hence, the 35 U.S.C. 102(e) critical date of the Miroslav CIP is not the filing date of the Nielsen et al. parent for (7) through (13). The Miroslav 35 U.S.C. 102(e) critical date for (7) through (13) is the Miroslav October 1, 1999 filing date, which is predated by Applicants' Declaration.

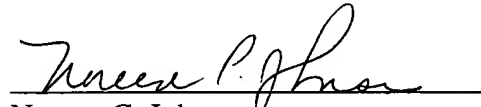
Applicants' Declaration establishes "invention of the subject matter of the rejected claim(s) prior to the effective date of the reference(s)." 37 C.F.R. §1.131. The rejections of claims 1 to 3, 9 to 29, 31 to 33, 36 and 37 under 35 U.S.C. §103(a) over Miroslav and Nielsen et al. and claims 4 to 8, 30, 34 and 35 under 35 U.S.C. §103(a) over Miroslav, Nielsen et al. and Fyvie et al. must be withdrawn.

In view of the foregoing remarks, reconsideration and allowance of claims 1 to 37 are respectfully requested.

^{*} The PTO rejection relies on Miroslav for this disclosure.

Should the Examiner believe that any further action is necessary in order to place this application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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4/2, 2002